

REMARKS

The Office Action dated October 9, 2007, has been received and carefully reviewed. The issuance of a further Office Action addressing all pending claims is respectfully requested in view of the following remarks.

TRAVERSAL OF RESTRICTION REQUIREMENT

The restriction requirement raised in the Office Action dated October 9, 2007, is respectfully traversed. Section 808 of the MPEP sets forth a two-part test for requiring restriction. First, the examiner must show that the claimed inventions are independent and distinct. Once this is done, restriction is still not proper unless the examiner can show that examining the two independent and distinct inventions in one application would constitute a serious burden. One way of establishing a serious burden is to show that the inventions are classified in distinct classes. In the present case, the Office Action does not satisfy either of these steps. Instead, the requirement essentially reads “the inventions are independent because there is a serious burden.” Neither independence of invention nor a burden is shown in any manner.

The Office Action indicates that the inventions are independent and distinct. Section 808.01 of the MPEP provides that “The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given (emphasis added).” Stating that the searching would be burdensome in no manner satisfies the requirements of MPEP 801-803 for establishing independent and distinct inventions. The Office Action therefore lacks any “particular reason” for finding the inventions to be independent and distinct and is improper for at least this reason.

The Office Action also fails to satisfy the second requirement of MPEP 808.01. The Office Action indicates that the two inventions will require a separate classification and search; however, it fails to identify the inventions or explain where they are classified. The Office Action therefore fails to follow the guidelines of MPEP 817, because the Office Action is lacking both a short description of the two inventions and a classification for each group. It is

respectfully submitted that the mere presence of different language in two claims does not alone make two claimed inventions “independent” or “distinct.”

So that the record is complete for a possible petition of this requirement, the following table compares claim 4 (including the limitations of claim 1 from which it depends) and claim 26, which allegedly describes an invention independent and distinct from the invention of claim 4.

Claim 4	Claim 26
A surface radiation conversion element for converting electromagnetic wave, which is radiated from a radiation source, to surface radiation, characterized in that	A surface radiation conversion element for converting electromagnetic wave, which is radiated from a radiation source, to surface radiation, comprising
an element body has a generally plate shape constituted with a material having a larger electric permittivity than air outside said element body and,	an element body having a generally plate shape constituted with a material having a larger electric permittivity than air outside said element body and,
in the inside of the element body,	in the inside of the element body,
a plurality of closed spaces are disposed whose electric permittivity is smaller than that of the material constituting the element body	a plurality of closed spaces are disposed whose electric permittivity is smaller than that of the material constituting the element body
and whose surfaces opposite to a radiation surface are generally flat,	and whose surfaces opposite to a radiation surface are generally flat,
<i>wherein a number of closed spaces near an edge of the element body near the radiation source is greater than in a central portion of the element body</i>	
and characterized in that	the element body comprising
a first member having a radiation source disposed on a side thereof	a first member having a radiation source disposed on a side thereof
and a second member disposed on the radiation surface side	and a second member disposed on the radiation surface side
are constituted to be in close adhesion, and said closed spaces are formed between said first member and said second member	in close adhesion with the first member, said closed spaces being formed in said first member and in said second member.

The “mounted on” language quoted by the examiner does not appear in claim 1, and it is not clear how that language supports the restriction requirement. The italicized language in the

above table was added by the previous amendment (making the previous version of claim 4 even more similar to present claim 26). As shown by this table, the primary differences between these claims are the presence of the highlighted word “between” in claim 1 and the word “in” in claim 26 and a description of the distribution of the closed spaces in claim 1. It is respectfully submitted that these differences do not make the inventions of claim 1 and claim 26 independent and distinct or constitute a serious searching burden. It is therefore respectfully requested that the examiner issue a new Office Action in which claims 1-14, 16-18 and 20-41 are examined or in which the requirements of Chapter 8 of the MPEP are satisfied.

APPLICANT IS PREJUDICED BY PIECEMEAL EXAMINATION

New claims 26-41 were added in an effort to further distinguish over the art of record. A proper examination of all claims would permit the applicant to determine which, if any, of claims 1-14, 16-18 and 20-25 need to be amended or cancelled. However, the examiner has failed to examine claims 26-41 or even minimally satisfy the requirements for justifying a restriction requirement. This failure to examine all pending claims or satisfy the requirements for restriction constitutes the piecemeal examination that MPEP 707.07(g) seeks to avoid. It is therefore respectfully submitted that the above response constitutes a full response to this incomplete Office Action. It is respectfully requested that the examiner issue a new Office Action in which claims 1-14, 16-18 and 20-41 are examined so that Applicant can provide a complete response and place the application in better condition for allowance or appeal.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies,


Application No. 10/787,188
Amendment dated November 6, 2007
After Final Office Action of October 9, 2007

Docket No.: 1248-0934P

to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

Dated: November 6, 2007

Respectfully submitted,

By  \$ 37,750
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Takata YOSHIKI

Application No.: 10/787,188

Confirmation No.: 4585

Filed: February 27, 2004

Art Unit: 2875

For: SURFACE RADIATION CONVERSION
ELEMENT, LIQUID CRYSTAL DISPLAY
DEVICE, AND METHOD OF PRODUCING A
SURFACE RADIATION CONVERSION
ELEMENT

Examiner: J. Y. Choi

REQUEST FOR REVIEW BY SUPERVISORY PATENT EXAMINER
PURSUANT TO MPEP 707.02

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Section 707.02 of the MPEP provides that:

The supervisory patent examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.


The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent *>Office< action with a view to finally concluding its prosecution.

In the present case, Applicant has added new claims to further distinguish over the art of record. Instead of examining these claims, the examiner has withdrawn them from consideration as being directed to a non-elected invention. No explanation as to why the inventions are independent or distinct was provided. No evidence of different classifications was provided.

Some claims in the two allegedly different inventive groups differ by one or two words as shown by the claim chart in the Reply filed concurrently herewith. It is respectfully requested that the examiner's supervisor review this application to the extent required by the MPEP and require that an Office Action examining all pending claims be issued.

Dated: November 6, 2007

Respectfully submitted,

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